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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,810	01/30/2001	Bart Victor	3977-8	1008

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NEW YORK, NY 10036-7311

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/772,810

Applicant(s)

VICTOR ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

In view of the Appeal Brief filed on June 27, 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 8-11 and 13-14 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

According the recently published "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (1300 OG 142, 22 November 2005), the analysis for determining patent eligible subject matter under §101 can be said to be subject to the following criteria:

1. Does the claimed invention fall within one of the four statutory categories (process, machine, manufacture or composition of matter)? If the answer to this criterion is no, then the claimed invention is not statutory eligible subject matter.
2. If the answer is yes to the first criterion, then does the claimed invention fall within a judicial exception? If the answer to this criterion is no, then the claimed invention would be statutory eligible subject matter.
3. If the answer is yes to the second criterion, then does the claimed invention provide a practical application of the judicial exception? If the answer to this criterion is yes, then the claimed invention would be statutory eligible subject matter, unless the claimed invention effectively preempts all substantial practical applications of the judicial exception, in which case the claimed invention would not be statutory eligible subject matter.
4. If the answer to the third criterion is no, then the claimed invention is not statutory eligible subject matter and is not eligible for patent protection.

With regards to the first criterion, the claimed invention is a method of fostering thinking comprising performing various steps in an attempt to enhance or facilitate discussion concerning the thoughts of various participants of a meeting. Certainly, the steps recited can be considered a "process" and therefore broadly falls within one of the four statutory categories of invention.

However, regarding the second criterion it is well settled that claims directed to nothing more than abstract ideas, natural phenomenon, and laws of nature (i.e. judicial exceptions) are not eligible and therefore are excluded from patent protection. Diehr, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., Chakrabarty, 447 U.S. at 309, 206 USPQ at 197; Parker v. Flook, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); Benson, 409 U.S. at 67-68, 175 USPQ at 675; Funk, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." Le Roy, 55 U.S. (14 How.) at 175. Instead, such "manifestations of laws of nature" are "part of the storehouse of knowledge," "free to all men and reserved exclusively to none." Funk, 333 U.S. at 130, 76 USPQ at 281. In this case, several of the method steps recited ("assembling a group of participants...", "causing the participants to discuss", etc.) are merely the manipulation of abstract ideas. It is the examiner's position that such manipulation of abstract ideas broadly falls into the above noted exclusions.

For claims including such excluded subject matter to be eligible, according to the third criterion the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 ("application of

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a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it “has no substantial practical application”). A practical application of the § 101 judicial exception can be identified in various ways:

- The claimed invention “transforms” an article or physical object to a different state or thing; or
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

In this case, the recited steps do not result in a transformation of an article or physical object to a different state or thing. All that is claimed is a process that fosters thinking in a selected group of participants. While there may apparently be a physical transformation in the form of constructing and reconfiguring the models made from building blocks, this is not the claimed result of the process. The claimed end result of the process is causing the participants to discuss their models and describe how the features of the models relate to the topic. This end result is not a transformation of an article or physical object from a different state or thing. Therefore, it is this examiner’s opinion that the judicial exception recited in the claims is not practically applied via a transformation.

For eligibility analysis, physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If the examiner determines that the claim does not entail the transformation of an article, then

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the examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In this case, it is the examiner's position that the claimed invention produces a result that is not useful, concrete and tangible. The claimed result here is "fostering thinking associated with a selected topic". First, the claimed invention of fostering thinking can arguably be considered to have a specific, substantial and credible utility. However, the claimed invention can not be said to produce a tangible result. Causing a group of participants to discuss the models and how they relate to the topic is an abstraction that is not practically applied and cannot be considered a tangible result. Also, it is this examiner's position that the claimed invention does not produce a "concrete" result. The claimed method of fostering thinking is not sufficiently concrete because the claim requires such a degree of subjective human judgment that a reasonably consistent result cannot be predictably or reliably assured. How can a series of process steps ensure that thinking is fostered in a group of participants? Certainly, instructing a group of participants to construct models and discuss the models they have constructed can potentially lead to a result of building models, but it is this examiner's position that the claimed process steps cannot lead to fostered thinking in a group of participants in a reliable and repeatable fashion.

Therefore, since the claimed method does not result in a physical transformation and does not produce a useful, concrete and tangible result, it is this examiner's position that the claimed judicial exception is not practically applied and is therefore not eligible for patent protection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-11 and 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;



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(F) The amount of direction provided by the inventor;

(G) The existence of working examples; and

(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The examiner has taken each of the above factors into account in making the determination that undue experimentation would be necessary in order for one of ordinary skill in the art to be able to practice the claimed method of fostering thinking in a reliably consistent manner. First, the breadth of the claims and nature of the invention recognize that appellant is seeking patent protection for essentially a method of making a group of human beings think in a certain manner (i.e. fostering thinking). Evaluation of the amount of experimentation necessary to practice appellant's claimed invention, however, is not based solely on these basic factors. The examiner must also take into consideration the level of predictability in the art, the amount of direction provided by the inventor, the existence of working examples and the quantity of experimentation needed to make or use the invention.

In this case, the claimed method of fostering thinking requires such a degree of subjective human judgment that a reasonably consistent result cannot be predictably or reliably assured. The fact that a human being is involved leaves open the myriad of ways in which humans can and do think. There is no guarantee, or any degree of reasonable assuredness, that a person could foster thinking in a group of participants in the manner recited in the claim. The level of predictability of fostering thinking in a

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group of people is suspect. The working examples set forth in applicant's specification do not provide concrete evidence that fostering thinking resulted from the claimed steps. Further, it is this examiner's position that the degree of subjectivity far outweighs all other factors in determining that the claimed invention requires undue experimentation to foster thinking in a group of participants.

In conclusion, the claimed invention contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by an article in The Technology Teacher titled "TECHNOTOWN - A School-Wide Design Technology Project" at pages 39-43 dated September 1994 (reference hereinafter referred to as TT; see also pages 13-15 in the same publication).

Prior to analysis of the claims with the TT reference, the examiner would first like to note that the pending application is assigned to Executive Discovery Ltd. which controls Lego. It is further noted at page 39, column 2 of the TT reference that Lego

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representatives attended the technology project discussed in the reference. Applicant is reminded of their duty to disclose information under 37 CFR 1.56. A requirement for information under 37 CFR 1.105 will follow the below rejection.

Regarding claim 1, the TT reference discloses a method for fostering thinking associated with a select topic (see last paragraph on page 43) comprising assembling a group of participants (see first paragraph on page 39 as well as table on page 40), causing the participants to construct models (see table on page 41, first paragraph on page 40, and table on page 40), reconfiguring the models as a plurality of new models (see steps 4, 5, and 6 in the table on page 41 as well as the first full paragraph on page 41), and causing the participants to discuss the models (see page 41 under "The Presentation of Technotown").

Regarding claims 2 and 3, see 2<sup>nd</sup> full paragraph on page 41 and bridging paragraph between pages 41 and 43. With respect to claim 3, it is inherent that "customers" are involved (see MPEP 2111, 2112).

Regarding claim 4, in as much set forth in the claim, a "physical link" is clearly provided (see table on page 40, for example).

Regarding claim 5, see 2<sup>nd</sup> full paragraph on page 41.

Regarding claim 6, again, see 2<sup>nd</sup> full paragraph on page 41 wherein it is inherent during the expression of opinions and analyzing that guiding principles for governing changes takes place.

Regarding claim 8, applicant is well aware of the shapes and connections of Legos.

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Regarding claim 9, see 2<sup>nd</sup> full paragraph on page 41 in relation to the job base.

Regarding claim 10, see 3<sup>rd</sup> full paragraph on page 40.

Regarding claim 11, see table on page 41.

Regarding claim 13, see page 41 and "The Presentation of Technotown."

Regarding claim 14, see discussion above.

***Requirement for Information Under 37 CFR 1.105***

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

37 CFR 1.105 - Requirements for information.

(a)

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

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(ii) Search : Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) Technical information known to applicant . Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

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- (i) A requirement for factual information;
  - (ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
  - (iii) Stipulations as to facts with which the applicant may agree or disagree.
- (4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
- (b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
- (c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

Based on the prior art The Technology Teacher reference discussed above and section (1)(iii) of 37 CFR 1.105, it appears that applicant has not provided information that is relevant to the claimed invention. It is further noted that applicant has not cited any prior art during the prosecution of this application.

In light of the reference above discussing Technotown in which a Lego representative was clearly present and the presumed fact that Lego should be aware of this reference, applicant is required under this Rule to provide all relevant information of reference similar in nature to the Technotown reference for the examination of this application.

For each reference hereinafter cited by applicant, applicant is required (1) to provide an explanation as to why each reference has been cited, (2) what specific feature in each reference is pertinent to respective limitations in the claims, and (3) how each reference cited defines over the claim(s) wherein each of (1), (2), and (3) should be meaningfully different. A simple statement that each of the references are relevant will not be sufficient. This requirement is reasonably necessary for examination in light of the extraordinary breadth of the claims submitted by applicant and the known prior art associated with Lego representatives. Because the applicant is presumably aware of such events, it is reasonable to require the applicant to provide the information needed so that the most relevant citations are fully considered.

### ***Response to Arguments***

As discussed above, new grounds of rejection have been presented. The 101 and 112 rejections have been maintained, for reasons set forth herein and in prior Office Actions.

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**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "TECHNOTOWN - A LEGO Experience" and "The Laboratory Schools LEGO-LOGO Project" disclose educational devices and methods projects using LEGO pieces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M, T, Th 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 10, 2006

  
EUGENE KIM  
SUPERVISORY PATENT EXAMINER

  
KURT FERNSTROM  
PRIMARY EXAMINER